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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,901	11/29/2001	Richard D. Ellis	130081	4144

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EXAMINER	
BEKERMAN, MICHAEL	
ART UNIT	**PAPER NUMBER**
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/998,901	ELLIS ET AL.	
	Examiner	Art Unit	
	MICHAEL BEKERMAN	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-15 and 22-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-15 and 22-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/07/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 3-15 and 22-25 in the reply filed on 12/27/2007 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 5 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 5, the term "is imperceptible to a human player" is a relative term which renders the claim indefinite. The term "imperceptible to a human player" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Different people may view performance differently, so while one person may notice the game slow down, another may not. Further, different computers may have more memory, so the step of receiving may perform differently for one computer as opposed to another.

Regarding claim 12, the term "imperceptible effect on performance of the game to a human game player" is a relative term which renders the claim indefinite. The term

"imperceptible effect on performance of the game to a human game player " is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Different people may view performance differently, so while one person may notice the game slow down, another may not. Further, different computers may have more memory, so the step of receiving may perform differently for one computer as opposed to another.

Regarding claim 23, this claim recites the limitations "increasing a power", "decreasing a power", and "giving the game object a new power". This is unclear. Does power refer to some functionality within the game? Is a game object supposed to have this "power" initially? Power appears to simply be an abstract concept that lacks any form of antecedent basis in the claim language. A new power is taken to read on any altered functionality of the game.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 3-15 and 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Spaur (U.S. Patent No. 6,196,920).** Spaur teaches a gaming advertising method and system that includes all of the limitations recited in the above claims.

Regarding claims 3, 4, 9-11, 14, 15, and 25, Spaur teaches, while a game is being played, detecting game elements (tags) in which advertisements can be placed (Column 9 Lines 50-64, Column 15 Lines 20-27 and 34-42, and Figures 12-17). Each of the game elements has criteria relating to whether the area is designed for a variable ad or a continuous ad (Column 9, Lines 50-64). Spaur downloads advertisements during game play (Column 8, Lines 43-46) that are either variable type or continuous type (Column 10, Lines 7-8) and assigned them to the appropriate tags. This represents a step of determining conforming advertisements. Spaur further teaches presenting the advertisement in the position of the game element (Column 10, Lines 27-29). The continuous advertisements of Spaur are described as being shown during the playing of the game, and thus do not interrupt game play. Spaur teaches an ad server, a game server, and a client machine (Figure 1).

Regarding claims 5, 6, 12, and 13, Spaur teaches spreading out the sending of packets to players which in turn minimizes the load spike (Column 10, Lines 49-50). This spreading out of packets is considered to be evidence of a dribble pipe, and by minimizing the load spike, should thus be "imperceptible to a human player".

Regarding claim 7, Spaur teaches forwarding statistics based on the displaying of the advertisement (Column 9, Lines 9-16).

Regarding claim 8 and 23, Spaur teaches the advertisements as being printed on the back of cards, and since the cards can be moved by a player while playing the game, this reads on interacting with the advertisement to modify the behavior of a game object (moving the card from one position to another). This reads on giving the card a "new power", the power to move positions.

Regarding claim 22, Spaur teaches the advertisement as comprising audio (Column 3, Lines 22-24). This reads on playing audio when a player interacts with the advertisement, as well as when the player does not interact with the advertisement.

Regarding claim 24, Spaur further teaches selecting (interacting with) an advertisement to receive more information on the advertisement. This represents a capability associated with brand information.

ALTERNATIVE Claim Rejections - 35 USC § 102

5. **Claims 3-7 and 9-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Heckel (U.S. Patent No. 6,036,601).** Heckel teaches a gaming advertising method and system that includes all of the limitations recited in the above claims.

Regarding claims 3, 6, 9-11, and 13-15, Heckel teaches locating advertising tags (plug-ins) in a game (the plug-ins inherently need to have criteria listing whether an ad has been assigned to this area or not) (Column 3, Lines 52-54), storing a set of advertisements on the console (Column 4, Lines 49-58), and dynamically inserting advertisements from the set into the game code associated with the plug-ins (Column 4, Lines 49-58). All of this is done when the user logs onto the game server (Beginning at

Column 4, Line 35), and thus, occurs while the game code is executing (when a user logs on, this is taken to be playing the game). From the specification, a dribble pipe appears to be a connection capable of transferring small amounts of information. The connections of Heckel have no such limitations. Therefore, Heckel's connection is taken to be a dribble pipe.

Regarding claim 4, Heckel takes into account scheduling information ("specific rate" is taken to meet the broad meaning of scheduling information), as well as advertising type and genre (demographic data is used as well) (Column 4, Lines 8-9).

Regarding claims 5 and 12, since Heckel teaches the computer as running the software (without crashing), the impact on performance is taken to be minimum.

Regarding claim 7, Heckel teaches the forwarding of information regarding the displaying of the advertisements (Column 3, Lines 4-9).

ALTERNATIVE Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 8, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (U.S. Patent No. 6,036,601) in view of Rashkovskiy (U.S. Patent No. 6,616,533).**

Regarding claims 8, 23, and 24, Heckel doesn't teach interaction between the user and the advertisement. Rashkovskiy teaches a game in which a player may click on an advertisement so that the game will pause and the user will be given the option of purchasing an item. It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow a game player to interact with advertising. This would allow immediate and abrupt feedback and profit for an advertiser. The capability to purchase an item is a capability associated with brand information. This also reads on providing a "new power" of purchasing an item.

Response to Arguments

In the response filed November 2, 2006, Applicant argues "Heckel makes clear that only after all the ad textures are loaded and ready, … play will commence. Thus, the Examiner's argument is directly contrary to the procedure described in Heckel". Examiner would like to submit the following example. A person playing a Nintendo Entertainment System (NES) gaming console puts in a gaming cartridge and powers on the unit. When the player begins interacting with the game through the gaming pad, that person is playing the game. If the player is required to enter personal information at the beginning of the game, such as a name or a "continue code", the person is still "playing the game". Since the game software is running on the NES, much like the software of Heckel is running on the client computer, the user is effectively playing the game. The portion of the game that the user is playing is not specified in the claim

language. Thus, while Heckel uses the language "play will commence", the user is still, in fact, playing the game upon entering user information.

Applicant further argues “Examiner may not simply assert…that Heckel's connection is a dribble pipe". Heckel's connection can transfer large amounts of data as well as small amounts of data. Depending on the amount of data being transferred at any given time, the connection of Heckel will act as a dribble pipe.

All other arguments were directed to recently canceled claims, and are therefore rendered moot. Based on amendments to the claims, new reference Spaur is submitted to further reject the pending claims.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/M. B./
Examiner, Art Unit 3622

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622